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JAN 10 2007 Docket No.: 29617/PM421A

Application No. 08/940,815
Amendment dated January 10, 2007
Reply to Office Action of July 10, 2006

REMARKS

Claims 1-25 were examined in the most recent official action dated July 10, 2006. The applicant appreciates the allowance of claims 4 and 15-19 and the indication that claims 2 and 3 would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Claims 22-25 stand rejected for an alleged lack of enablement and claims 8, 11, 12, and 25 stand rejected for alleged indefiniteness. Claim 8 stands rejected as anticipated by Tamai, WO93/04875 ("Tamai"). Claims 1, 5, 7, 11, 12, and 21 stand rejected as anticipated by and/or obvious over Murasaki, EP 0 427 970 ("Murasaki"). Claims 1, 5-14, and 21 stand rejected as obvious over Omori, JP 63-56690 ("Omori") in view of de Ruyter, FR 2643351 ("de Ruyter"). Claim 20 stands rejected as obvious over Omori in view of de Ruyter and in further view of Semmler, DE 41 01 293 ("Semmler").

By way of this response, the rejection to claim 1 is respectfully traversed; claim 2 has been amended into independent form to include all limitations of the base claim; claim 8 has been amended into dependent form; claims 22-25 have been canceled; and claim 26 has been added. Other amendments have been made that will be noted herein.

No fee is required for presenting claim 2 in independent form or for new claim 26.

Claims 1, 5-14, 20, and 21 are Allowable

The applicant respectfully traverses the rejections to Claim 1 as obvious over Omori in view of de Ruyter and as separately anticipated or obvious over Murasaki. The evidence of record indicates that the combination of Omori and de Ruyter creates an inoperable device, and the examiner admits the same. Further, Murasaki cannot be interpreted as disclosing a device that meets the claim limitations.

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The Rejection Based on Omori and de Ruyter Should Be Withdrawn

By way of review, in the previous amendment filed April 7, 2006, the applicant filed a Declaration of Bret Marschand that provided evidence that combining Omori and de Ruyter would create an inoperable device. Specifically, by rotating Omori's applicator tip 90°, one would arrive at a device that creates a tortuous tape path. The tape would drag along a corner and likely buckle and flip over itself.

The reasoning of the examiner regarding the combination is deficient. The examiner first asserts that he is not convinced that the combination of Omori and de Ruyter would create an inoperable device. However, he next admits that the combination of Omori with de Ruyter requires a practitioner "to make [a] required modification to the tip of Omori to accommodate twisting of the tape from the peg to the tip." See official action, page 10. By the examiner's own admission, the proposed combination does not accommodate twisting of the tape and must include some further, undefined modification to the tip.

It is black letter law that where a combination creates an inoperable device -- here a device that does not accommodate twisting of the tape -- there is no suggestion or motivation to make the combination. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion... to make the modification." MPEP § 2143.01 (V). The only evidence of record indicates that the combination of Omori and de Ruyter produces an inoperable device because the tape would flip over itself, and the examiner agrees that the combination does not accommodate twisting of the tape without some further modification.

The examiner's attempt to make up for the deficiencies of the combination by asserting that de Ruyter suggests to one of ordinary skill in the art to modify the tip of Omori is likewise deficient. Even where all limitations are known in the art, there still must be a

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motivation to combine the references. See MPEP § 2143.01 (IV). Here, there is no motivation to modify the inoperable device because there is no motivation to create the inoperable device in the first instance. In other words, any motivation to modify the combination is destroyed by the underlying lack of modification to arrive at the combination in the first instance.

Further, even if a successful modification could be made, the examiner fails to define what the modification to the combination would be. The examiner further provides no evidence how this undefined modified device would still read on claim 1. Specifically, how would one modify the tip of Omori such that the path of the tape around the edge is perpendicular to the edge so that the device is still operable? Where is the suggestion for this specific modification? There is simply no evidence, findings or even argument in the record to show how the device would be modified by one of ordinary skill (and still read on the claims).

It is respectfully submitted that any modifications to the tip to accommodate a twisted tape amount to pure hindsight reconstruction by the examiner. The examiner cannot create an operable device from the inoperable device without using the disclosure of this application as a template.

The Marschand Declaration Must Be Given Its Full Weight

The Office fails to accord the Declaration of Bret Marschand its full evidentiary value. The Office argues that Applicant's Declaration "is mere conjecture based on the drawings of Omori." The Office appears to be confusing attorney argument with evidence presented by way of a declaration. The declarant, Bret Marschand, is an engineer and experienced in the field of correction tape dispensers. The declaration is testimonial evidence by an experienced engineer regarding the function of the examiner's proposed combination.

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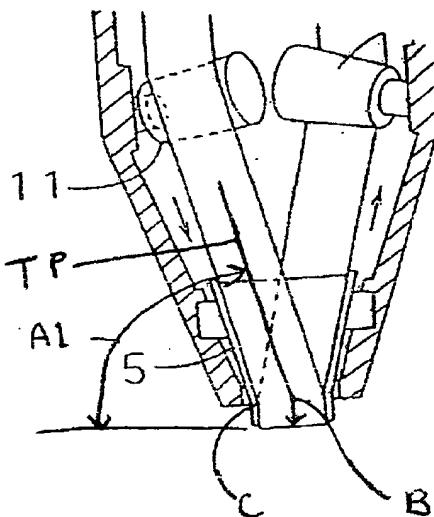
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This is not "mere conjecture" as asserted by the examiner. The examiner must give the Declaration its proper evidentiary weight, and withdraw the rejection to claim 1 in view of same.

The Rejection Based on Murasaki Should Be Withdrawn

Claim 1 recites, in part, that the path of the tape around the edge is in a plane substantially perpendicular to the edge of the tip. Murasaki does not disclose a correction tape dispenser where the path of the tape is perpendicular to the edge as it travels around the edge.

The same technical principles outlined in the Marschand Declaration apply with equal force to the Murasaki disclosure because Murasaki has the same problems as the combination of Omori and de Ruyter. Fig. 1 of Murasaki, reproduced below, depicts a correction tape dispenser with a tape path TP that approaches the tip at an angle other than substantially perpendicular. This angle is denoted on Fig. 1 by the applicant as A1. For the tape path TP to be perpendicular to the edge around the edge as claimed, the tape path must include a bend B at corner C of the applicator tip. As the tape travels the tape path TP, the corner C would wear on the tape at the bend B and deflect the brittle correction tape off the backing tape as described in the Marschand declaration. Further, the tape would likely flip over itself as also described in the Marschand declaration.



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Thus, the disclosure of Murasaki should not be interpreted as disclosing a tape path perpendicular to the tip edge, because such an interpretation would result in an inoperable correction tape dispenser.

On the other hand, the following Fig. 2 is a depiction of the applicant's understanding of how the applicator tip of Murasaki works. Here, the tape path TP has the same angle A1, but there is no awkward bend in the tape path at a corner adjacent the tip edge.

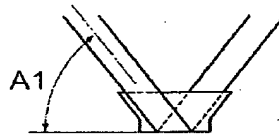


Figure 2.

While this interpretation of Murasaki creates an operable correction tape dispenser, the path of the tape is not perpendicular to the edge while it travels around the edge as claimed. Instead, the device maintains a consistent tape path that is always at an angle A1 other than the perpendicular.

“Affidavits or declarations attacking the operability of a patent cited as a reference must rebut the presumption of operability by a preponderance of the evidence.” MPEP § 716.07. As outlined above, the Marschand Declaration is also effective to explain why Murasaki should not be interpreted as disclosing a device with a tape path perpendicular to the tip edge. Further, the applicant's representatives have proffered an interpretation of Murasaki that preserves its operability. Accordingly, the examiner must determine whether it is more likely than not that the device described by Murasaki operates as the applicant has proffered, and not in the manner that applicant asserts will render the device inoperable.

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Because Murasaki can only be interpreted to operate where the path of the tape is not substantially perpendicular to the tip edge, Murasaki fails to anticipate claim 1. Because there is no suggestion within Murasaki of how to modify the tip such that the tape path is perpendicular to the tip edge without rendering the tape dispenser inoperable, there is no suggestion to do so. Accordingly, claim 1 is allowable over Murasaki.

The Claims Depending from Claim 1 are Allowable

Dependent claims 5-14, 20, and 21 are allowable for at least the same reasons that claim 1 is allowable. In particular, the separate rejection of claim 8 as anticipated by WO '875 has been rendered moot, because claim 8 has been amended to depend from claim 1 (without prejudice or disclaimer). Nevertheless, the applicant respectfully traverses the examiner's position that previously examined claim 8 is supported only by the embodiment of Figs. 8 and 9. Fig. 1 includes posts 7 and 9, for example, each of which provide support for the guide element recited in the claims.

Claims 8 and 11 stand rejected as indefinite because it is allegedly not clear if the axis is parallel to the feed direction or if the plane is parallel to the feed direction. Claims 8 and 11 have been amended to clarify that it is the plane that is parallel to the feed direction.

Claim 12 stands rejected as indefinite because "the tip edge direction" lacks antecedent basis. Claim 12 has been amended to recite "the edge" which has antecedent basis in claim 1.

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Claims 2 and 3 are Allowable

The examiner has indicated that claim 2 would be allowable if rewritten to include all limitations of the base claim and any intervening claims. Claim 2 has been amended to recite all limitations of previously examined claims 1 and 2. Accordingly, independent claim 2 and dependent claim 3 are allowable.

The Rejections to Claims 22-25 are Moot

Claim 22 stands rejected for a lack of enablement because the specification allegedly does not enable guide means including first and second posts. In furtherance of prosecution, claims 22-25 have been canceled without prejudice or disclaimer.

However, the applicant respectfully traverses the examiner's position that the specification enables only guide means including first, second, and third posts, and that the specification fails to enable guide means including first and second posts. "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." See MPEP § 2164.01 (*citing U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988)).

One of ordinary skill in the art would be able to make the guide means with two posts, because he or she would understand that the correction tape bears against posts 7 and 9 as shown in Fig. 1. This construction would take no experimentation, much less undue experimentation. Further, Figs. 8 and 9 explicitly depict a guide means including two posts. See specification, page 5, lines 21-23 ("In the construction illustrated in FIGS. 8 and 9, the tip member 5 has tape guide means consisting [of] a pair of opposed guide pegs 22, 23 on opposite sides thereof..."). Thus, the examiner has failed to carry his burden to show that one

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of ordinary skill in the art could not make and use the claimed invention without undue experimentation. See MPEP § 2164.04. In any event, the rejection should be withdrawn as moot.

Claim 24 stands rejected because the specification allegedly fails to enable the guide means comprising guide wings extending from the tip. The applicant respectfully traverses this position, but again, solely to advance prosecution of this application, the applicant has canceled this claim without prejudice or disclaimer.

Claim 25 stands rejected as indefinite because it is allegedly not clear what is to be encompassed by "the distal end" of the tip. Claim 25 has been canceled without prejudice or disclaimer, and thus this rejection is moot.

Claim 26 is Allowable

Claim 26 recites all limitations from claim 1 and further includes the limitation that the path of the tape from the guide means toward the edge is in a direction substantially perpendicular to the edge. No applied reference discloses or suggests this claimed limitation. Further, the examiner has previously indicated that this claim language would render claim 1 allowable. Accordingly, allowance of claim 26 is respectfully requested.

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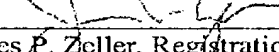
CONCLUSION

In view of the above amendment, the applicant believes the pending application is in condition for allowance. The Office is authorized to charge our Deposit Account No. 13-2855 under Order No. 29617/PM421A the fee for a petition for a three-month extension of time.

The undersigned is authorized to draw from this account.

January 10, 2007

Respectfully submitted,

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